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09/470,180	12/22/1999	JAY MERVES	72167.000112	5863
21967 7590 08/14/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			EXAMINER CUFF, MICHAEL A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY
DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON DC 20006-1109

MAILED
FROM DIRECTORS OFFICE

AUG 13 2008

TECHNOLOGY CENTER 3600

In re Application of:
Jay MERVES et al.
Appl. No. 09/470,180
Filed: December 22, 1999
For: **STRUCTURED FINANCE
PERFORMANCE ANALYTICS SYSTEM**

: **DECISION ON PETITION TO
: HAVE AN IDS CONSIDERED AND
: TO WITHDRAW AN IMPROPER
: REQUIREMENT FOR INFORMATION
: UNDER 37 C.F.R. 1.181**

This is a decision on Applicant's Petition under 37 CFR 1.181 received on June 05, 2008 requesting consideration of an Information Disclosure Statement (IDS) received December 17, 2007 and withdrawal of an improper requirement for information under 37 C.F.R. 1.105.

The Petition is **GRANTED**.

A review of the file record reveals that on December 17, 2007, after a non-final Office action and in accordance with 37 C.F.R. 1.97 and 37 C.F.R. 1.98, petitioners submitted an Information Disclosure Statement (IDS) containing 280 references to be considered by the Examiner.

On April 9, 2008, the Examiner issued a final Office action indicating that the IDS filed on December 27, 2007 was not considered. The Examiner mentioned that the IDS has 280 items, that many references do not have relevant dates prior to the filing date of the application let alone the priority date, that many of the NPL references are missing dates all together, and that certain references don't appear to have much relevance to the current application.

Further, in the final Office action mailed April 9, 2008, the Examiner imposed a 37 C.F.R. 1.105 (a)(1)(iii) requirement for information indicating that as a result of the problems with the IDS, the petitioners were to provide the relevance of each reference in the December 17, 2007 IDS.

Petitioners argue that the Examiner's failure to consider any part of the IDS is contrary to law and Office policy. First, Petitioners cite MPEP 609 which states that

there is no requirement that the information [submitted in an IDS] must be prior art references in order to be considered by the examiner. Second, Petitioners cite MPEP 609.05(a) indicating that the Examiner is not entitled to ignore the entire IDS when only some of the references fail to comply with 37 C.F.R. 1.97 and 37 C.F.R. 1.98. Third, Petitioners assert that whether particular references do not, in the Examiner's judgment, appear to be relevant, is not a sound basis for a complete failure to consider any reference in the IDS. Fourth, Petitioners assert that the outright number of items in an IDS does not justify an outright refusal to consider any reference cited in the IDS.

Further, Petitioners argue that the requirement for information under 37 C.F.R. 1.105(a)(1)(iii) is overbroad and contrary to the procedures set forth in the MPEP. More specifically, Petitioners argue that: 1) the requirement is extremely broad, rather than "narrowly tailored", 2) the requirement fails to "clearly indicate" a sound "basis for the requirement", 3) the requirement fails to state "how the information is necessary to the examination", 4) the "scope of the information required" is set forth in a shotgun fashion, rather than being "carefully specified", and 5) the requirement of providing a concise statement of relevance of each reference submitted in an IDS was removed by the Office in 1992.

MPEP 609 states that once the minimum requirements of 37 C.F.R. 1.97 and 37 C.F.R. 1.98 are met, the examiner has an obligation to consider the information. MPEP 609 further states that there is no requirement that the information must be prior art references in order to be considered by the examiner. MPEP 609.05(a) states that if a reference does not comply with all the requirements of 37 C.F.R. 1.97 and 37 C.F.R. 1.98, the Office may refuse consideration of that reference only. The MPEP makes no provision for not considering an IDS in its entirety when an Examiner deems that some references are not relevant. The MPEP also makes no provision for not considering an IDS in its entirety due to the number of references cited. **Therefore, the Examiner erred in not considering the IDS submitted December 17, 2007.**

37 C.F.R. 1.105 (a)(1) states that an examiner may require information as may be reasonably necessary to properly examine or treat the matter, for example: (i) relevant commercial databases, (ii) search information, (iii) Related information: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention, (iv) Information used to draft application, (v) Information used in invention process, (vi) Improvements, (vii) In use, (viii) Technical information known to applicant including factual information pertinent to patentability. MPEP 704.14(a) describes that the requirement should state why the requirement has been made and how the information is necessary to the examination. Further, MPEP 704.14 states that the requirement for information should be narrowly specified and limited in scope.

The Examiner's requirement to provide the relevance of each reference in the IDS submitted December 17, 2007 under 37 C.F.R. 1.105 (a)(1)(iii) is not supported by

that section. Further, the requirement by the Examiner fails to state how the information is necessary to the examination. Still further, the requirement cannot be considered narrowly specified and limited in scope as a request to provide the relevance of each reference is a matter of opinion, not fact, which may have unlimited scope. **Therefore, the Examiner erred in requiring the applicant to provide the relevance of each reference in the IDS submitted December 17, 2007 under 37 C.F.R. 1.105.**

Accordingly, the petition is granted and the application will be promptly forwarded to the Examiner for consideration of the IDS submitted on December 17, 2007. A notice of consideration and if needed a new Office action will be mailed to the applicant. Further, the requirement for information under 37 C.F.R. 1.105 is hereby withdrawn.

SUMMARY: The Petition is **GRANTED**.

Any questions regarding this decision should be directed to Supervisory Patent Examiner F. Ryan Zeender at (571) 272-6790.



Wynn Coggins, Director
Technology Center 3600
(571) 272-5350

FZ/snm: 7/23/2008

SM
